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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,545	11/24/2003	Jean-Claude Marcotte	400500	4582

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55 EAST MONROE STREET  
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CHICAGO, IL 60603-5803

EXAMINER

AMERSON, LORI BAKER

ART UNIT PAPER NUMBER

3764

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/720,545	MARCOTTE, JEAN-CLAUDE	
	Examiner	Art Unit	
	L. Amerson	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2005.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 17 and 18 is/are allowed.  
 6) ☒ Claim(s) 1-16 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **Response to Arguments**

### ***Claim Objections***

1. Claim 13 is objected to because of the following informalities: line 2, "its attachment" lacks antecedent basis. Appropriate correction is required. A rejection on the merits has not necessarily been made.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- a. Claims 1-5, 9-10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Zaffaroni. Zaffaroni discloses a device comprising a first rounded end, second rounded end and an s-shaped intermediate portion connecting the first and second end such that the ends and the intermediate portion lie in a plane and are spaced from each other (fig. 6) and a fulcrum on the intermediate portion. Regarding the language, "for exercising the Kegel muscle of a female", "for insertion into the female's vaginal/anal cavity", "such that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity" and "for bearing against the front wall and back wall of the Kegel muscle" have not been given patentable weight because the recitations are purely functional in nature and do not recite any structure. In response to applicant's argument that the examiner is misinterpreting the

teachings of Zaffaroni and the reference is used for entirely different purposes, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, as broadly claimed, the applicant has not indicated that the intermediate portion and ends lie in the same plane nor that the anal and vaginal cavity are of the same user. As to claim 2, the fulcrum is proximate the second rounded end (fig. 6). As to claim 3, an arc on the intermediate portion is proximate the first end (fig. 6). As to claims 4-5, the ends are of a spherical shape. As to claim 9, the mass about the fulcrum is even. As to claim 10, the intermediate portion is of circular cross-section.

b. Claims 1, 4-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Jacobs. Jacobs discloses a device comprising a first rounded end, second rounded end for insertion into a female's vaginal and anal cavity and capable of having an s-shaped intermediate portion connecting the first and second end such that the ends and the intermediate portion lie in a plane and are spaced from each other and a fulcrum on the intermediate portion. Regarding the language, "for exercising the Kegel muscle of a female" and "for bearing against

the front wall and back wall of the Kegel muscle” have not been given patentable weight because the recitations are purely functional in nature and do not recite any structure. The rounded ends are of a spherical shape where a second end extends progressively in tapered fashion to the intermediate portion.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

c. Claims 1-3, 9-10 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Teran. Teran discloses a device comprising a first rounded end, second rounded end and an s-shaped intermediate portion connecting the first and second end such that the ends and the intermediate portion lie in a plane and are spaced from each other and a fulcrum on the intermediate portion. Regarding the language, “for exercising the Kegel muscle of a female”, “for insertion into the female’s vaginal/anal cavity”, “such that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity” and “for bearing against the front wall and back wall of the Kegel muscle” have not been given patentable weight because the recitations are purely functional in nature and do not recite any structure. In response to applicant's argument that the reference is used for entirely different purposes, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, as broadly claimed, the applicant has not indicated that the intermediate portion and ends lie in the same plane nor that the anal and vaginal cavity have to be from the same user. As to claim 2, the fulcrum is proximate the second rounded end (fig. 2). As to claim 3, an arc on the intermediate portion is proximate the first end (fig. 2). As to claim 9, the mass about the fulcrum is even. As to claim 10, the intermediate portion is of circular cross-section. As to claim 15, the device is comprised of steel (col. 2, paragraph 0019).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

d. Claims 7-8, 11-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs as applied to claim 1 above and further in view of Ritchie. Jacobs discloses all of the limitations of the claimed invention except for the first sphere having a diameter of 5/8 of an inch, 1.1 inches for the second diameter and 3.4 inches from the first end to the second end. Thus, Ritchie teaches an end being a sphere (22), but does not teach the specific size dimensions of the instant invention. Ritchie teaches that a body (14) is capable of being varied in size as needed depending on the anatomical requirements of a

user (0032). It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of the teaching of Ritchie that the dimensions of a body are dependent of the size of the user. Furthermore, absent a teaching as to criticality that the dimensions of the spheres be 5/8 in, 1.1 inch and 3.4 inches in length from end to end, this particular agreement is deemed to be known by those skilled in the art since the instant application and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7,9 (CCPA 1975).

3. Claims 17-18 allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Amerson whose telephone number is (571) 272-4971. The examiner can normally be reached on Mon.-Fri from 9-6 p.m. Interviews Tue. and Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "L. Amerson". The signature is fluid and cursive, with a large initial "L" and a stylized "A".

L. Amerson